



REMARKS

1. **Status Of The Claims.** Claims 28-35 are pending in the subject application. Claims 28-35 have been rejected on final. Claims 28-35 were previously presented. Claims 1-27 have been canceled without prejudice. Applicant respectfully reserves the right to pursue any non-elected claims, canceled or otherwise unclaimed subject matter in one or more continuation, continuation-in-part, or divisional applications.

2. **Traverse Of Official Notice.** The Examiner has “noted that MacDonald teaches the features of dye release agent such as via microencapsulation and features of a non-aqueous liquid component”. *Office Action at Page 4, Paragraph 5.* If the note is to be interpreted as the Examiner taking official notice that MacDonald in view of common knowledge or facts not in the record teaches the features of a “dye release agent such as via microencapsulation” or “features of a non-aqueous liquid component” encompassed by the limitations of any of claims 28-35, then the Examiner is respectfully requested by Applicant to:

- i) provide an explicit basis on which the Examiner regards the matter as subject to official notice; and
- ii) if the statement is of the Examiner’s own personal knowledge the Applicant respectfully requests an Affidavit of the Examiner.

The Applicant respectfully challenges and traverses the official notice of the Examiner or provides remarks which evidence that the McDonald reference does not disclose the “features of dye release agent such as via microencapsulation” or the “features of a non-aqueous liquid”, as follows.

United States Patent No. 7,053,029 to MacDonald (“McDonald”) does not disclose the “features of a non-aqueous liquid”. McDonald teaches only “an over-the-counter liquid soap, Kimberly-Clark Professional antibacterial Clear Skin Cleanser (PCSC C2001-1824)”. However, disclosure of the trademark or trade name of the Clear Skin Cleanser product does not teach the composition of the product. The trademark or trade name of a product may

remain consistent over time while the composition may not. Therefore, it is not possible to know the features of the Clear Skin Cleanser at all based on what is taught by the MacDonald reference.

Additionally, what is commonly known of the Clear Skin Cleanser referred to in the MacDonald reference is in the form of the Material Safety Data Sheet for the Clear Skin Cleanser. The MSDS for the Clear Skin Cleanser does not indicate that the product is non-aqueous, but to the contrary evidences that it is clear liquid soap liquid with a floral odor having a pH of 6.4 with a specific gravity of 1.017-1.037 (water having a specific gravity of 1). *Material Safety Data Sheet, Page 3, attached as Exhibit A.* The fact that the MSDS states that the Clear Skin Cleanser has a pH of 6.4 and that the specific gravity is very close to that of water evidences that the Clear Skin Cleanser contains water and is not non-aqueous.

The Applicant respectfully requests that the Examiner support by citation of a patent, patent application, or technical article, or a citation within the MacDonald reference itself which unambiguously supports the Examiner's statement that the MacDonald reference teaches "the features of a non-aqueous liquid component." If the statement is of the Examiner's own personal knowledge the Applicant respectfully requests an Affidavit of the Examiner.

See also, Declaration of Walls at Paragraphs 34-36 and Declaration of Goodin at Paragraphs 34-36.

With respect to the Examiner's notice that MacDonald teaches "features of dye release agent such as via microencapsulation", the Applicant refers the Examiner to the MacDonald reference itself which only makes general reference to "microencapsulation" in the phrase "such as microencapsulation". *See MacDonald, col. 3, lines 35-36.* It is well understood that a prior art reference must be enabling under Section 35 U.S.C. §112, first paragraph. MacDonald's general use of the term "microencapsulation" in the MacDonald reference is insufficient to enable a person of ordinary skill to make and use microencapsulation for the purpose of keeping the first and second components separate as described by MacDonald and is similarly insufficient to enable a person of ordinary skill to make the invention of claims 28-35.

The Examiner has already indicated that “MacDonald et al. is silent with respect to the liquid hand soap comprising capsules that rupture” because the “presumption is supported by the use of similar materials and in similar production steps.” *Office Action mailed January 16, 2008, Page 6.* However, MacDonald does not claim any invention which includes the limitation of microencapsulation and therefore the MacDonald reference cannot be presumed to be enabled with regard to the use of microencapsulation.

The Declaration of Walls at Paragraphs 9, 10, 34, 35, and 36 evidences that MacDonald would not enable a person of ordinary skill in the art to make and use microencapsulation for the purposes of dye release.

See also, the Declaration of Goodin at Paragraphs 9, 10, 34, 35, and 36 which evidences that MacDonald would not enable a person of ordinary skill in the art to make and use microencapsulation for the purposes of dye release.

The Applicant respectfully requests that the Examiner support the noted statement with specific patents, patent applications, or technical articles which show the use of similar materials and similar production steps as encompassed by the limitations of claims 28-35. If the statement is of the Examiner’s own personal knowledge the Applicant respectfully requests an Affidavit of the Examiner.

3. **French Publication 2 717 184 of Rothan.** The Examiner has cited French Publication 2 717 184 of Rothan (“Rothan”) which is published in the French language and a copy was provided to the Applicant without an English translation. The Applicant respectfully requests that the Examiner provide an English translation of the Rothan reference, unless the translation made by Applicant of certain portions of the Rothan reference is correct, as follows.

Beginning on Page 1, line 49 of Rothan:

--The microspheres: In this technique the antiseptic soap (having a pH of 5.5) contains tiny capsules containing a dye coated with a film that permeabilize due to change of pH (for example 6 pH) to release the dye into the soap.--

If the above translation is not correct the Applicant respectfully requests the Examiner provide an English translation of the Rothan reference.

4. The Rejections Under 35 U.S.C.A. Section 103 As Being Unpatentable over MacDonald et al. In View of Rothan Are Overcome.

In the present application, the Examiner rejected claims 28-34 as being unpatentable over United States Patent No. 7,053,029 to MacDonald (“McDonald”) in view of Rothan.

To reject a claim based on combining prior art elements according to known methods, the office must resolve the Graham factual inquiries and provide a finding that the prior art included each element claimed. *MPEP §2143 A (1)*. The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR, 550 US at ___ 82, USPQ2d at 1395*. If any these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. *MPEP §2143 A (1)*. Additionally, “If the proposed modification or combination of the prior art would change the principal of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render claims prima facie obvious” *MPEP Rule 2143.01 VI*.

The MacDonald Reference Is Not Enabled .

The Examiner indicates that MacDonald et al. discloses “a method of washing hands with a soap composition that includes polyvinyl alcohol, borax citric acid and a dye (col 1, line 65 to col col 2, line 30).” *Office Action at Page 2*. The Applicant believes that this statement

by the Examiner with respect what McDonald teaches is overly broad. McDonald teaches “If the cleaning aid is a soap, the soap is preferably made from a first component including liquid soap and a dye, and a second component including ascorbic acid and iron chloride. . . .The soap may alternatively have liquid soap and polyvinyl alcohol, and optionally, a second component including borax and citric acid. . . .The soap may alternatively have a first component including liquid soap, a dye and polyvinyl alcohol, and a second component including borax, citric acid, ascorbic acid and iron chloride. The components are mixed together to produce the soap. The soap changes viscosity from a gel to a liquid and simultaneously changes color from green to blue. . . .” *McDonald at Col. 1, line 65 through Col. 2, line 30*. Specifically, McDonald claims “a soap for cleaning comprising a first component including liquid soap, a dye and polyvinyl alcohol, and a second component including borax, citric acid, ascorbic acid and iron chloride, wherein the components are mixable together to produce soap.” See for example, *McDonald, Claim 9 (emphasis added.)*

The Applicant believes that the Examiner has inadvertently omitted “liquid soap” within the first component. This is important because Applicant claims a liquid soap which can be distinguished from McDonald because it provides “a non-aqueous carrier” while McDonald does not teach this limitation as above-explained in Section 2 of the instant response.

The Examiner also indicates that McDonald discloses that “the dye is kept separate until the mixing occurs and a change in color is observed-e.g. via microencapsulation (col 3, lines 27-38).” The Applicant respectfully asserts that this interpretation by the Examiner of McDonald is overly broad. McDonald teaches that “it preferably contains at least one dye or pre-dye and a modifying agent that causes a change to occur. These components may be kept in a two part dispenser or may be kept together with one component inactive by some means, such as microencapsulation, until sufficient physical stimulus results in their effective mixing. The components may also be kept separate by being non-miscible mixture of two phases.” *McDonald at Col. 3, lines 29-38*.

The Applicant believes that the Examiner over broadly characterizes McDonald as being enabled with respect to separating the first component of the soap taught by McDonald

which includes liquid soap and a dye from the modifying agent that causes a change to occur by microencapsulation. However, as explained by the remarks above, the McDonald patent does not include a claim including a microcapsule for the purpose of separating liquid soap containing a dye from the modifying agent that causes change to occur. As such, the McDonald reference cannot be presumed to be enabled with respect to separating the first component of the soap taught by McDonald which includes liquid soap and a dye from the modifying agent that causes a change to occur by microencapsulation.

Additionally, McDonald uses the term “microencapsulation” only once in the entire reference. The general but unenabled reference to microencapsulation is not supported by any detailed description or working examples as to how to make and use a microcapsule for the purpose of separating liquid soap containing a dye from the modifying agent that causes change to occur. Moreover, McDonald specifically does not teach or provide any guidance or any working example that would anticipate or would make obvious the invention of claim 28 which includes the limitation of “a plurality of non-aqueous carrier stable capsules entrained in said non-aqueous carrier” and the limitation of “rupturing said plurality of capsules by exposure to said amount of water to release said encapsulated material”. Nor does the term “microencapsulation” inherently include these limitations. General guidance with respect to the particular form of the invention is not sufficient to support an obviousness rejection. *In re Roemer*, 258 F.3d 1303, 59 USPQ 1527 (Fed. Cir. 2001). See also *In Re Kumar*, 418 F.3d 1361, 76 USPQ 2d 1048 (Fed. Cir. 2005)(“to render a later invention unpatentable for obviousness, the prior art must enable a person of ordinary skill in the field to make and use the later invention. . .”).

See also, the Declaration of Walls in the entirety and specifically at Paragraphs 9-10 and the Declaration of Goodin in the entirety and specifically at Paragraphs 9-10 each of which declare that the MacDonald reference does not provide sufficient guidance to allow a person of ordinary skill in the art at the time of the invention to make and use the invention of claim 28.

The Combination of McDonald and Rothan Does Not Teach Every Element Claimed.

Nor does the combination of McDonald with Rothan teach all the limitations of claim 28. Rothan teaches that “in this technique the antiseptic soap has a pH of 5.5”. *Rothan at Page 1, last full paragraph*. The fact that Rothan teaches that the liquid antiseptic soap has a pH evidences that the antiseptic soap is an aqueous antiseptic soap. Additionally, Rothan teaches that the aqueous antiseptic soap “contains tiny spheres containing dye coated with a film that permeabilizes during change of pH (for example 6 pH). *Id.* It appears clear to the Applicant from the Rothan reference itself that Rothan uses change in pH as the means for rupturing the film to release the dye so that the capsule can also be stable in the aqueous antiseptic soap. Rothan does not teach the claim limitation of “rupturing said plurality of capsules by exposure to said amount of water to release said encapsulated material”.

The Examiner also states that Rothan does not specifically indicate that the envelope is water soluble. *Office Action at Page 2*. The Examiner notes as to Rothan that “the cellulose acetylphthalate is a homologue to applicant’s cellulose capsule (see page 13, line 5 of the specification) and it would be expected to have similar properties-the Patent Office is not equipped to perform laboratory testing. . . .(e.g. water soluble)” *Office Action at Page 3*. The Applicant nor the USPTO need not resort to any laboratory testing. The Rothan reference teaches that cellulose acetylphthalate “film” is permeable to change in pH. *Rothan at Page 1, last full paragraph beginning with “les microspheres”*. Rothan does not teach that the cellulose acetylphthalate film is permeable to water as claimed by Applicant.

See also, the Declaration of Walls at Paragraphs 1-17 and the Declaration of Goodin at Paragraphs 1-17 which evidence that the film cellulose acetylphthalate is water insoluble and that a chemist of ordinary skill in the art would not generally know from the disclosure of the cellulose acetylphthalate film in Rothan that the cellulose capsules listed in the specification would be water soluble because the cellulose acetylphthalate film disclosed by Rothan being insoluble in water would lead away from rather than toward that conclusion.

Additionally, the Applicant believes the Examiner improperly uses information in the Applicant’s patent application to support the obviousness rejection. *In re Kuehl*, 475 F.2d 658, 177 USPQ 250 (CCPA 1973). Without use of applicant’s information which relates to capsules

stable in a non-aqueous carrier and also rupture by exposure to water, there would be no teaching at all in the combination of McDonald and Rothan to support the Examiner's speculation that the Rothan film might be water soluble. One having no knowledge of applicant's particular cellulose homologues would not speculate as to whether Rothan's cellulose acetylphthalate film would be water soluble, nor find it obvious to use homologues of Rothan's cellulose acetylphthalate film in the form of a non-aqueous stable capsules entrained in a non-aqueous carrier. This is especially true because Rothan specifically indicates that the cellulose acetylphthalate film is permeable to changes in pH not to exposure to water.

Also, Applicant's own teaching cannot be used to support an obviousness rejection based on equivalency. *In re Ruff*, 256 F.2d 590, 595, 118 USPQ 340, 345 (CCPA 1958). The applicant has not indicated in the patent application's description that the particular capsules described on Page 13, lines 1-9 have similar properties to cellulose acetylphthalate film. The applicant above-remarks evidence that the cellulose acetylphthalate film of Rothan and the particular compositions of the capsules have dissimilar properties. Additionally, even though certain kinds of microcapsules may be taught in the prior art, the Applicants themselves invented and taught the use of particular kinds of capsules which can be used to encapsulate materials which can be entrained in a non-aqueous carrier such that the capsules subsequently exposed to water rupture to release the encapsulated material as claimed. The combination of McDonald and Rothan do not teach this use when the claim is read as a whole and not as isolated elements. As such, Applicant's own disclosure of these inventions cannot be used by the Examiner to support a finding that one of ordinary skill in the art would have recognized that homologues of the Rothan cellulose acetylphthalate film could be used as claimed by the Applicant.

Moreover, homology should not be automatically equated with prima facie obviousness because the claimed invention and the reference art must be viewed "as a whole". *MPEP 2144.09 II*. McDonald in combination with Rothan does not appraise the ordinary artisan of the significance of the use of any particular cellulose capsule or any other kind of capsule whatsoever in the context of entrainment in a non-aqueous carrier which subsequently releases encapsulated material when subsequently exposed to water. The Examiner focuses on the

claimed limitation of solubility of the capsule material in water while the claimed invention requires the capsule material to be stable in a non-aqueous carrier and also rupture upon subsequent exposure to water.

Also, if the Examiner's note (*Office Action at Page 2, last sentence*) is to be interpreted as the Examiner taking official notice that the cellulose acetylphthalate film is a homologue to applicant's cellulose capsule in view of common knowledge or facts not in the record, then the Examiner is requested by Applicant to provide an explicit basis on which the Examiner regards the matter as subject to official notice. The Applicant further traverses any notice based on the above explained functional differences explicitly described by Rothan itself which differentiates his cellulose acetylphthalate film from the particular kinds of cellulose capsules taught by the Applicant for the claimed method and further based on the statements and facts evidenced by the Declarations of Walls and Goodin.

No Reasonable Expectation of Success.

To reject a claim as obvious there must be some reasonable expectation of success. *MPEP §2143.02*. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR, 550 US at ___ 82, USPQ2d at 1395*. In the instant case, the combination of McDonald and Rothan simply do not disclose a non-aqueous carrier in which non-aqueous stable capsules are entrained which by subsequent exposure to water rupture to release the encapsulated material. Where all the limitations of the claimed invention are not disclosed by the combination of references there can be no expectation of success of a person of ordinary skill making the claimed invention. *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)* ("The prior art does not disclose or suggest the . . . or convey to one of ordinary skill a reasonable expectation of success of doing so."). The combination of McDonald and Rothan does not yield the invention of claim 28 and modifying Rothan to make the claimed invention would require a change in the function of the cellulose acetylphthalate film disclosed by Rothan to be permeable to water as opposed to pH as described therein.

Declaration of John Walls Under §1.132.

Now referring the Examiner to the Declaration of John Walls (“Walls”), Walls is an inventor of the claimed invention and has reviewed the McDonald and the Rothan reference and declares that the cellulose acetylphthalate film disclosed by Rothan would not be permeable to water. *Declaration of Walls at Paragraphs 1-17.* The cellulose acetylphthalate film would not function in the same manner as the claimed invention which ruptures by exposure to water. *Id.* Walls further declares that the properties of the cellulose acetylphthalate film disclosed by Rothan are not principally the same as, and are unlike the properties of, the cellulose capsules listed in the specification of the above-identified patent application at page 13, lines 4-5. *Id.*

Declaration of Jonathan Goodin Under §1.132.

Now referring the Examiner to the Declaration of Jonathan Gooding (“Goodin”), Goodin has also reviewed the McDonald and the Rothan reference and declares that the cellulose acetylphthalate film disclosed by Rothan would not be permeable to water. *Goodin Declaration at Paragraphs 1-17.* The cellulose acetylphthalate film would not function in the same manner as the claimed invention which ruptures by exposure to water. *Id.* Goodin further declares that the properties of the cellulose acetylphthalate film disclosed by Rothan are not principally the same as, and are unlike the properties of, the cellulose capsules listed in the specification of the above-identified patent application at page 13, lines 4-5. *Id.*

Conception Prior To The Effective Date of the MacDonald Reference Coupled With Due Diligence To a Reduction To Practice.

The MacDonald reference has an effective date of March 27, 2002 which is within one year of Applicant’s earliest claimed priority date of United States Provisional Patent Application No. 60/ 423,231, filed November 2, 2002. The inventors believe that they conceived of the invention of claim 28 prior to the effective date of the MacDonald and that the coception was coupled with due diligence from prior to the reference date to a subsequent

reduction to practice. The Applicant's respectfully request that the Examiner allow this Response to be Supplemented with a Declaration of the Inventors under Section 1.131 which evidences conception prior to the effective date of the MacDonald reference coupled with due diligence to a reduction to practice.

In summary the rejection of claims 28-34 as being unpatentable over the combination of MacDonald in view of Rothan is overcome because MacDonald or Rothan or both are not enabled with respect to microencapsulation as claimed, the combination does not disclose all the limitations of claim 28 or any claim made ultimately dependent upon claim 28, or because there is no reasonable expectation of success of making the invention in view of the combination or because the MacDonald reference must be withdrawn because the inventors conceived of the invention of claims 28-35 prior to the effective date of the MacDonald reference and evidences continuous diligence to completion of the invention.

5. The Rejections Under 35 U.S.C.A. Section 103 As Being Unpatentable Over McDonald et al. In View of Rothan And Further In View of Rau Are Overcome.

The Examiner indicates that MacDonald et al. discloses "a method of washing hands with a soap composition that includes polyvinyl alcohol, borax citric acid and a dye (col 1, line 65 to col col 2, line 30)." The Applicant has above-explained that this statement by the Examiner appears overbroad and incorporates by reference the above remarks herein in response.

The Examiner also indicates that McDonald discloses that "the dye is kept separate until the mixing occurs and a change in color is observed-e.g. via microencapsulation (col. 3, lines 27-38)." The Applicant has above-explained that this statement by the Examiner appears overbroad and incorporates by reference the above remarks herein in response.

The Examiner also indicates that MacDonald does not explicitly disclose the features of rupture of the envelope containing the dye, the time dependence parameter and a fragrance. The Applicant believes this statement is overly broad as the MacDonald reference does not

explicitly, impliedly or inherently disclose any features of an microcapsule containing dye or a time dependence parameter as explained in the above-remarks hereby incorporated herein in response.

The Examiner also indicates that “in an analogous art, Rothan teaches that is well known to use a liquid soap in which a colorant is encapsulated into microspheres such as cellulose acetylphthalate that ruptured due to external parameter as time indicia (page 1, lines 12-14 and 49-57). *Office Action at Page 4*. Lines 12-14 of the Rothan reference states that “The present invention is a remedy to the contamination. An antiseptic liquid soap changes color during washing of hands of nurses after some duration during washing to guarantee antiseptic (2 minutes of contact of the soap with the hands according to the authors).” Lines 49-57 of the Rothan reference state, “The microspheres: In this technique the antiseptic soap (having a pH of 5.5) contains tiny capsules containing a dye coated with a film that permeabilize due to change of pH (for example 6 pH) to release the dye into the soap.”

If the Examiner believes that this translation is not correct, the Applicant requests an English translation from the examiner.

The lines 12-14 of Rothan provides a general statement which does not provide any guidance as to how to make or use a liquid soap that changes color to guarantee 2 minutes of contact time with the liquid soap. With respect to lines 49-57 of Rothan, Applicant has above remarked the Rothan is a publication not a patent and is not presumed enabled and that a person of ordinary skill in the art could not make the soap envisioned by Rothan without undue experimentation. The Applicant incorporates by reference the remarks herein in response.

The Examiner states that the Rau reference discloses features of water soluble envelopes and fragrance as a release agent. *Office Action at Page 4*. The Applicant has above remarked that Rau discloses an embodiment of a gasified solid component which is a blend of sugar, glucose, and lactose which is very soluble in water and that the liquid phase must be virtually anhydrous to prevent premature dissolution of the gasified solid. The Applicant incorporates those remarks by reference herein in response.

The Examiner states that “Because the references teach the similar methods and elements, the claims would be obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.” *Office Action at Page 4.*

The rationale for issuing an obviousness rejection based on simple substitution of one known element for another to obtain predictable results requires findings that the prior art contained a device which differed from the claimed device by substitution of some components; that the substituted components and their functions were well known in the art; that one of ordinary skill could have substituted one known element for the other and the results of the substitution would have been predictable.

The combination of MacDonald, Rothan and Rau does not teach similar methods and elements between them or as to the method of claim 28. MacDonald does not teach any working examples or detailed guidance as to any methods or elements of microencapsulation and certainly does not teach the method or elements of claims 28-35. Rau teaches methods and elements which are entirely dissimilar to MacDonald and Rothan. In particular, one of ordinary skill in the art would know that the gasified solids of Rau cannot be substituted for cellulose acetylphthalate film (insoluble to water) encapsulated dye disclosed by Rothan because the gasified solids described by Rau would rapidly decompose in the disinfectant soap disclosed by Rothan thereby rendering the composition of Rothan inoperable for its intended purpose. Similarly, one of ordinary skill would know that the gasified solids of Rau cannot be predictably substituted into MacDonald because the many combinations of first components and second components described by MacDonald occur in chemical environment sufficiently aqueous to decompose the gasified solid described by Rau making these embodiments of the MacDonald reference inoperable. *See Declaration of Walls at Paragraphs 27-28 and Goodin at Paragraphs 27-28.*

The Examiner further states that “Furthermore, the claims would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan. In particular, it would have been well within the purview of the skill of the

artisan to implement the feature of a water soluble envelope with fragrance and dye ingredients to gain the benefits of a time dependence release mechanism that ha a pleasant sensorial perception.” *Office Action at Page 4.*

The rational for issuing an obviousness rejection based on use of a known technique to improve similar devices in the same way requires findings that the prior art contained a base device upon which the claimed invention can be seen as an improvment; that the prior art contained a comparable device that was improved in the same way as the claimed invention; and that one of ordinary skill in the art could have applied the known improvement technique in the same way to the base device and the results would have been predictable to one of ordinary skill in the art.

As evidenced by the Declarations of Walls and Goodin, if the Examiner is referring to Rothan as the base device and to Rau as the comparable device that was improved in the same way as the claimed invention, that a person of ordinary skill in the art could not have applied Rau to Rothan with predictable results. As declared above, placing the gasified solid into Rothan would simply result in decomposition of the gasified solid making Rothan inoperable as a soap. *See Declaration of Walls generally and specifically Paragraphs 11-17, 24-26, 27-29, 30 and 32-33; and Declaration of Goodin generally and specifically Paragraphs 11-17, 24-26, 27-29, 30, and 32-33.*

If the Examiner is referring to MacDonald as the base device and to Rau as the comparable device that was improved in the same way as the claimed invention, that a person of ordinary skill in the art could not have applied Rau to MacDonald with predictable results. As explained by the remarks above, MacDonald does not describe a first component and a second component each virtually anhydrous in which the gasified solid would remain stable. Placing the gasified solid into the MacDonald reference would make MacDonald inoperable for its intended purpose as a soap that provides an observable change after a period of time. *See Declaration of Walls generally and specifically Paragraphs 9-10, 24-26, 27-29, 31, 32-33; and Declaration of Goodin generally and specifically Paragraphs 9-10, 24-26, 27-29, 31, 32-33.*

Additionally, if the Rau gasified solids are placed into virtually anhydrous liquids that most of these liquids would not be useful separately as hand wash compositions. As examples, anhydrous liquids disclosed by Rau such as corn oil, avocado oil, safflower oil, mineral oil, petrolatum, ethanol, isopropanol, butanol would not be utilized separately as hand wash compositions. Also, even if these compositions are obtained virtually anhydrous as required by Rau, these compositions would be sufficiently hygroscopic to accumulate sufficient water to degrade the gasified solids in part or in whole. Substituting dye as described by either of the Rothan reference or MacDonald reference for gas in the gasified solid would simply lead to a discoloration of the liquid over a relatively short period of time making the MacDonald or the Rothan references inoperable for the intended purpose of indicating change of color during use of the composition. *See Declaration of Walls at Paragraphs 32-33; and Declaration of Goodin at Paragraphs 32-33.*

Moreover, Rau would not be utilized by a person of ordinary skill in the art for the purpose of providing a predictable time dependence release mechanism for a variety of reasons. First, Rau does not provide any teaching that the gasified solids can be used as a predictable time dependence release mechanism. Rau discloses that when mixed with water “a crackling sound can be heard for about 4 minutes” (see for example Rau, Column 5, lines 66-67). This result does not afford any predictable time dependence as to release of the gas or of any dye which would occur after a period of time as described by MacDonald or Rothan. *See also Declaration of Walls at Paragraphs 32-33; and Declaration of Goodin at Paragraphs 32-33.*

In summary, the Applicant believes that certain statements made by the Examiner relating to MacDonald, Rothan, and Rau are overbroad as to what each reference teaches and when the scope of the teaching is properly characterized the references do not teach similar methods and in fact teach methods which if combined would render the each inoperable for its intended purpose or when the scope of the teaching is properly characterized not all the limitations of the invention of claims 28-35 are taught; or that the rationale for an obviousness rejection based on simple substitution cannot be made because not all the findings can be made or because simple substitution would yield an inoperative product or would yield an unpredictable result; or that the rationale for an obviousness rejection based on use of a known

technique to improve similar devices cannot be made because all of the finding can be made or because one of ordinary skill in the art could not have applied the known technique in the same way to the base device because it would yield an inoperative product or would yield an unpredictable result.


CONCLUSION

The Applicant has canceled without prejudice claims 1-27. Claims 28-35 were previously presented. The Applicant believes that the Declarations of Walls and Goodin coupled with Applicant's remarks overcome the Section 103 rejections in view of the combination of MacDonald and Rothan and the combination of MacDonald, Rothan and Rau. The Applicant believes that it can swear behind the MacDonald reference and has requested additional time to supplement the response with evidence of prior conception coupled with diligence to a reduction to practice of the invention. The Applicant believes that each of claims 28-35 is now in condition for allowance and respectfully requests allowance of claims 28-35.

Dated this 17 day of April, 2009

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